REMARKS

Claims 11-14, 16, 18-19, 27-31 and 38-45 are pending in the application. Claim 31 is objected to because of an informality. Claims 11-14, 16, 18-19, 27-31 and 38-45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,792,466 to Saulpaugh et al. in view of U.S. Patent No. 5,493,692 to Theimer et al.

Reconsideration is requested. No new matter is added. The rejections are traversed. Claims 11-14, 16, 18-19, 27-31 and 38-45 remain in the case for consideration.

REJECTIONS UNDER 35 U.S.C. § 103(a)

In responding to the Applicant's previous amendment, the Examiner indicated that the arguments were not persuasive. The Examiner makes three arguments to support his position. First, the Examiner asserts that "Saulpaugh teaches of '*a space facility [that is] provided to which a client may register or unregister to obtain notification when something is added to or removed from the space*'" (Office Action dated January 9, 2006, page 16, lines 5-7, citing to Saulpaugh, column 42, lines 42-44; emphasis in original). This point is repeated where the Examiner recites that "Saulpaugh teaches of '*storage (both transient and persistent) providers are examples of services that enable clients and services to store, advertise, and address content*'" (Office Action dated January 9, 2006, page 17, lines 16-18, citing Saulpaugh, column 16, lines 24-27; emphasis in original). The Examiner goes on to argue that Saulpaugh is "improving on a known technology of utilizing JavaSpace as a persistent store for messaging" (Office Action dated January 9, 2006, page 16, lines 19-20). The Examiner also argues that "'*the API layer may also provide an interface for messages to communicate between objects or pass objects, such as Java objects. API's may be provided to discover an object repository or "space", find a particular object, claim and release an object, and write or take an object to or from the object repository*'" (Office Action dated January 9, 2006, page 17, lines 11-15, citing Saulpaugh, column 11, lines 49-55; emphasis in original). Second, the Examiner argues that the advances in technology enable storing large amounts of data in small devices (Office Action dated January 9, 2006, page 16, lines 16-18). Third, the Examiner argues that Saulpaugh describes implementing the "'*message capable network layer . . . from the network classes provided by the Java2 Micro Edition (J2ME) platform . . . for smaller footprint devices that do not have the resources for a full Java platform*'" (Office Action dated January 9, 2006, page 17, lines 3-6, citing Saulpaugh, column 12, lines 30-35; emphasis in original). The Examiner continues by explaining that "'*[t]he distributed computing environment protocol definition does not require nor imply the*

Docket No. 2705-187   Page 7 of 10   Application No. 09/882,221

use of Java on a device. Nor does it preclude it'" (Office Action dated January 9, 2006, page 17, lines 8-10, citing Saulpaugh, column 15 line 57 through column 16, line 4).

There are three problems with the Examiner's response to the Applicant's arguments. First, because Saulpaugh makes it clear that Jini and JavaSpaces are inadequate to his task, Saulpaugh teaches away from using Jini and JavaSpaces. Second, the Examiner is arguing from hindsight. And third, the Examiner is citing to sections of Saulpaugh that have nothing to do with the Applicant's arguments.

The claims describe using Jini and JavaSpaces

Whatever Saulpaugh does or does not teach, Saulpaugh makes it abundantly clear that he considers Jini and JavaSpaces inadequate for the purpose of his patent. This is made clear by his repeated remarks about the limitations of Jini and JavaSpaces. Examples of where Saulpaugh makes such remarks have been cited in the response to the Office Action dated July 12, 2005, and will not be repeated here. The Applicant points out that these citations are merely exemplary: Saulpaugh describes at length at other points about how Jini and JavaSpace do not provide the functionality he requires.

Thus, whatever "space facility" Saulpaugh describes, it is definitely not implemented with Jini and/or JavaSpaces. But the claims explicitly recite "a JavaSpace persistent store" (e.g., claims 11, 14, 42, and 44). In contrast, Saulpaugh expounds at length about the limitations of Jini and JavaSpaces, and makes it clear that in his opinion, his "space facility" cannot be implemented using Jini and/or JavaSpaces.

The Examiner's citations to Saulpaugh, column 11, 16, and 42 cited above, along with other citations to columns 8 and 32, if they mention a "space facility" at all, only describe "space facilities" in the abstract. Accordingly, these sections of Saulpaugh need to be read in context. Given how Saulpaugh makes it clear that, in his opinion, Jini and JavaSpaces are inadequate to the task of implementing a "space facility", the proper interpretation of these sections of Saulpaugh requires reading in Saulpaugh's understanding that the "space facility" cannot be implemented using Jini and/or JavaSpaces. This means that Saulpaugh teaches away from the claimed invention.

The Examiner is reasoning from hindsight

In responding to the Applicant's arguments, the Examiner argued that technological advances have made storage in small devices available. But at the time that Saulpaugh filed his patent application, small devices did not offer sufficient storage to support Java. This is

Docket No. 2705-187   Page 8 of 10   Application No. 09/882,221

made clear by the Examiner's citation to Saulpaugh, column 4. But in that section, Saulpaugh was, again, indicating why Jini was incapable of providing the functionality he needed, showing again that Saulpaugh teaches away from Jini and/or JavaSpaces. But more than that, the Examiner is making a bald statement that devices today provide sufficient storage. Aside from the fact that the Examiner's statement is unsubstantiated, that devices today might provide sufficient storage does not support an obviousness rejection. In arguing that devices today are capable of providing the storage needed, the Examiner is arguing from hindsight, which is impermissible. In rejecting claims as obvious under 35 U.S.C. § 103(a), the Examiner is not permitted to argue based on hindsight. Since Saulpaugh makes it clear that devices at the time did not provide sufficient space to suit his needs, to argue that advances in technology made small devices with sufficient storage possible is arguing from hindsight.

In addition, the Examiner has completely overlooked a central word in his citation to Saulpaugh: that the devices require a certain amount of "processing". In other words, storage space alone is not enough for small devices to provide the functionality Saulpaugh describes. The Examiner has not made any comment about whether it was obvious that devices would have sufficient processing capability.

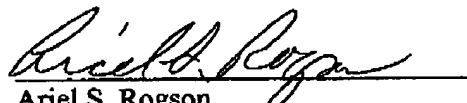*The Examiner cites to sections of Saulpaugh that are off point*

In citing to columns 8, 11, 12, and 16 of Saulpaugh, the Examiner points to a number of different topics: a gate factory, a message capable network layer, and APIs. The Applicant fails to understand the Examiner's reasoning in citing these sections. None of these citations have anything to do with how the "space facility" might be constructed. Instead, these citations discuss other aspects of Saulpaugh. Because the citations have nothing to do with the construction of the "space facility" of Saulpaugh, these sections are without any merit.

In particular, the Examiner cites to the end of column 15 and the start of column 16, where Saulpaugh describes the distributed computing environment protocol definition. The Applicant thinks it worth noting that Saulpaugh states that the definition does not require, imply, or preclude the possibility of Java on the device. The Applicant argues that this shows that Saulpaugh's "space facility", whatever it is, is not implemented in Java. If the device discussed in columns 15-16 of Saulpaugh can operate without implementing Java, then the "space facility" is not implemented using Jini and/or JavaSpaces. And if the device under can support Java or not, then that choice is for whatever other purpose the device might want to support Java: it has nothing to do with the implementation of the "space facility".

Docket No. 2705-187   Page 9 of 10   Application No. 09/882,221

For the foregoing reasons, reconsideration and allowance of claims 11-14, 16, 18-19, 27-31 and 38-45 of the application as amended is solicited. The Examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

Ariel S. Rogson
Reg. No. 43,054

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613
Customer No. 20575

Docket No. 2705-187   Page 10 of 10   Application No. 09/882,221

PAGE 11/11 * RCVD AT 3/9/2006 7:13:06 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/12 * DNIS:2738300 * CSID:5032744622 * DURATION (mm-ss):03-40